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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,293	08/28/2000	Lawrence T. Cohen	2447-012	7384

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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 09/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/649,293

Applicant(s)

COHEN, LAWRENCE T.

Examiner

George R Evanisko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,9 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,9 and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/12/02 has been entered.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 18 has been renumbered to claim 16 and will be referenced as claim 16.

The claims are objected to because of the following informalities: It is suggested to provide a clean version of all pending claims in the next amendment since the claims without markings contain additional words not present in the marked up version of the claims. As an example amended claim 13, line 2, has "evenly" in the claim, but the marked up version has "evenly" deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 13, 15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, line 2, "evenly" is vague since in line 3 the claim has the receptors being closer together.

In claim 5, "adjacent electrodes" is vague since claim 4 uses "consecutive electrodes".

In claim 17, line 2, "toward" should be deleted. In addition, "closer" and "further" are vague since they are relative terms and it is unclear which direction "further" is. In addition, shouldn't the electrodes be spaced closer at the apical end (further) than at the basal end (closer)?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 1, 6, and 12-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuzma et al (6304787). For claims 6, 13, and 14, although Kuzma has an equal spacing between electrodes, Kuzma still meets the limitations in the claim since the claim is an open ended claim, a “comprising” claim, and does not state that the distance between “consecutive electrodes” is different. Kuzma’s electrodes 1, 2, 4, 7, 11, etc., can be considered the applicants claimed “electrodes” having different spacings.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hochmair et al (4284856).

Claims 1, 12, 14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hochmair-Desoyer et al (“An eight Channel Scala Tympani Electrode for Auditory Prostheses”).

On page 46, the fourth full paragraph, Hochmair-Desoyer describes the spacing between contacts belonging to the same channel as 1.5 mm and between two neighboring contacts of different channels as 0.5 mm. Since the claim is a “comprising” claim (an opened ended claim) and since the claims do not specify which electrodes are being limited, but just use the broad term “electrodes”, Hochmair-Desoyer meets the claim limitations and is capable of meeting the functional use recitations presented in the claims since there will be different channel electrodes at the apical end 0.5 mm apart and same channel electrodes 1.5 mm apart at the basal end. In addition, the use of three consecutive electrodes (different channel and then same channel) will provide the claimed uniformly graduated electrodes. Finally, for claim 16, Hochmair-Desoyer states on page 45, that the contacts are placed as near to excitable nerve-structures as possible.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 9, 13, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hochmair et al (4284865).

Hochmair is capable of meeting the functional use recitations presented in the claims. In addition, Hochmair discloses the claimed invention except for the spacing to be uniformly graduated between consecutive electrodes. Hochmair does disclose the schematic of the cochlea showing the frequency response, the use of at least four different frequency ranges, the stimulating of the lower frequency stimulation sites near the apex, and does disclose that the electrode contacts can be positioned on the device to stimulate a region of the cochlea for a desired frequency response and in accordance with the frequency response of the cochlea. This provides a clear suggestion that the spacing of the electrodes can be modified to change the distance between adjacent electrodes to have the spacing between adjacent electrodes at the apical end to be less than the spacing at the basal end, the spacing to be different in different regions, and the spacing to be uniformly graduated between consecutive electrodes to correspond to the a desired frequency response and in accordance with the frequency response of the cochlea. The determination of the most appropriate spacing of the electrodes by routine experimentation would, therefore, be prima facie obvious to one having ordinary skill in the medical art.

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Response to Arguments


Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are 703 306-4520 for regular communications and 703 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.


George R Evanisko
Primary Examiner
Art Unit 3762

9/15/2

GRE
September 15, 2002